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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,427	04/12/2004	Liam Casey	120-343	2564
76661 7590 10/17/2008 DAVID A. DAGG, ESQ. 44 CHAPIN ROAD NEWTON, MA 02459				
EXAMINER GAY, SONIA L				
ART UNIT 2614		PAPER NUMBER		
NOTIFICATION DATE 10/17/2008		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DAVE@DAVEDAGG.COM

Office Action Summary

Application No.

10/822,427

Applicant(s)

CASEY ET AL.

Examiner

SONIA GAY

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-12, 14- 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-12, 14- 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/5508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This action is in responses to Amendment submitted on 7/30/3008 in which claims 1 -5, 7 - 12, 14 - 18 are presented for examination.

Claims 8-12 and 14 recite the language "operable to" which is similar to "configured to" or "adapted to". MPEP 2106 (II C) states "the subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that *suggests*" or *makes optional* but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim language. The following examples of language that may raise a question as to limiting effect of the language in a claim:

- A. statements of intended use of field or use,
- B. "adapted to" or "adapted for" clauses,
- C. "wherein" clauses,
- D. "whereby" clauses.

This list of examples is not intended to be exhaustive. See also MPEP 2111.04."

Since "configured to" and "adapted to" suggest or make optional the limitations following the claim language, these limitations may not be given weight in future office actions.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claims 8-12 and 14 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention.

Claims 8 -12 and 14 recite "a system for providing voice communications over a packet-based data communication network comprising 'logic' ". A claim directed to "logic" is non-statutory. Further, on page 13 lines 11 -13, the specification discloses that the logic is "computer program instructions".

While the claims recite a series of steps or acts to be performed, a statutory “process” under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing (Reference the May 15, 2008 memorandum issued by Deputy Commissioner for Patent Examining Policy, John J. Love, titled “Clarification of ‘Processes’ under 35 U.S.C. 101”). The instant claims neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huat et al. (US 7,072,959) in view of Poier et al. (US 2002/0124090), and further in view of Baeder (US 2004/0156356).

For claim 1, Huat et al. discloses a method and system with logic operable for providing voice communications over a packet-based data communication network comprising:

receiving a call request (column 5 lines 40 – 43; column 6 lines 65 – column 7 line 11);

determining whether the requested call would span a region (Fig. 6; column 3 lines 54 – 60; column 4 lines 31 – 41; column 5 lines 5 – 15, 40 – 43; column 7 lines 1- 34);

Yet, Huart et al fails to teach determining whether the requested call would span a gateway connecting a local network to an external network; and, in response to a determination that the requested call would not span the gateway connecting the local network to the external network, increasing a size of packets used in the call.

However, Huart et al, discloses that the network regions are subnets interconnected by communication links for the purpose of transmitting packets of voice, video and data across the Internet (column 3 lines 2 – 6, 34 – 35);

Moreover, Poier et al. discloses a network with subnets interconnected by communication links across the Internet wherein one subnet, a corporate intranet, is a local network connected to an external network which includes remote individual and intranet partner users for the purpose of establishing a virtual private network (VPN) which runs across a diverse set of operating systems ([0002] [0041] [0046] [0049]; Fig. 3 and 4).

Additionally, Baeder discloses method and system for providing voice communications over a packet-based data communication network (Abstract) wherein a gateway comprises a module generating voice data packets of different lengths according to the distance between the calling and called party such as increasing the packet size for calls wherein the calling party is local to the called party for the purpose of providing Voice over Internet Protocol (VoIP) calls ([0009][0016][0018] [0019] [0021][0036]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the teachings of Huart et al. with the teachings of Poier et al. and Baeder so that the subnets disclosed above in Huart et al. include a local network with a gateway

connected to the external network for the purpose of transmitting voice, video, data, and media across a virtual private network; and, the call manager which manages the establishment of calls between the network endpoints as disclosed in Huart et al. (column 3 lines 61- 62) functions as the gateway controller disclosed in Baeder ([0014]) wherein the call manager communications bandwidth and codec information to the gateway to for the purpose of determining the adjustment of the packet size of intra- and inter-region VoIP.

3. Claims 2 – 3, 5, 7, 9-10, 12, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huart et al. (US 7,072,959) in view of Poier et al. (US 2002/0124090), and further in view of Baeder (US 2004/0156356), and further in view of Michelson et al. (US 7,283,541).

For claims 2 and 9, the teachings of Huart et al. , Poier et al., and Baeder further disclose determining whether said total delay would exceed said predetermined maximum delay is responsive to indicating whether a called party phone is local to a calling party phone (Baeder : [0009] [0022] [0044] [0045]), yet fail to teach if a packetization delay component is increased for the requested call.

However, Michelson et al. discloses determining whether a total delay for he requested call would exceed a predetermined maximum delay if a packetization delay component is increased for the requested call (column 4 lines 13 – 20; column 5 lines 20 -21) for the purpose of increasing the size of a packet in a local VoIP call (Abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the teachings of Huart et al., Poir et al., and Baeder with the teachings of Michelson et al. to determine whether a total delay for the requested call would exceed a predetermined maximum delay if a packetization delay component is increased for the call for the purpose of increasing the size of packet in a local VoIP call as disclosed above in Baeder.

For claim 3, 5, 7, 10, 12, and 14, the teachings of Huart et al., Poir et al., Baeder, and Michelson et al., further disclose

determining whether a total delay of the requested call would exceed a predetermined maximum delay if a packetization delay component is increased for the requested call responsive to a directory number of a calling party phone and a directory number of a called party phone; and, increasing the size of packets used in the requested call only in the event that the packetization delay for the requested call can be increased without exceeding the predetermined maximum delay (Baeder : [0009] [0022] [0044] [0045]; Michelson et al. : column 4 lines 13 – 20; column 5 lines 20 -21).

wherein said increasing said packets used in said call comprises increasing said size of packets used in said call to a packet size above a default packet (Baeder : [0003][0034] [0037] [0048]).

wherein said maximum delay is a value that cannot be exceeded without adversely impacting the voice quality of the call (Michelson et al.: column 1 lines 64 – column 2 line 2; column 5 lines 2 – 6).

4. Claims 4 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huart et al. (US 7,072,959) in view of Poier et al. (US 20020124090), and further in view of Baeder (US 2004/0156356), and further in view of Kotabe et al. (US 2003/021904).

For claims 4 and 11, the teachings of Huart et al. , Poier et al., and Baeder fail to teach determining whether a calling party phone and a called party phone can process an increased packet size, and only increasing said size of packets used in the call in the event that both said calling party phone and said called party phone can process said increased packet size.

However, Kotabe et al. discloses a method and system of a calling party using a query packet to notify a called party of a maximum delay quantity of a packet transfer ([0024][0025][0061][0062]) for the purpose of the enabling the called party to adaptively determine and optimize its own received packet buffering quantity for voice call quality in the system ([0037]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the teachings of Huart et al., Poier et al., and Baeder with the teachings of Kotabe et al. so that both a calling and called party phone can process an increased packet size by sending a query packet from the calling party to notify the called party of the total delay associated with an increased packet size for the purpose of enabling the called party to optimize the received packet buffer to handle these packets.

5. Claims 15 - 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huat et al. (US 7,072,959) in view of Poier et al. (US 20020124090), and further in view Baeder (US 2004/0156356), and further in view of Amos (US 2004/0259544).

For claims 15 - 18, the teachings of Huat et al., Poier et al., and Baeder further disclose wherein the external network is the internet (Huat et al. : column 3 lines 2-3; Poier et al. : Fig.3 and 4, [0046]); wherein a calling party or called party phone terminated the requested call is located on the local network (Huat et al.: Fig. 6, column 5 lines 40 – 43; Poier et al.: [0047] [0049]); and, determining whether the requested call would span a gateway connecting a local network to an external network further comprises determining whether a called party or calling party is being used remotely on the external network through the virtual private network gateway (Huat et al.: Fig. 6 and column 5 lines 40 – 46; Poier et al.: [0048] [0049]).

Yet, the teachings of Huat et al., Poier et al. and Baeder fail to teach wherein the local network is a wireless network.

However, Amos discloses an IP phone connected to a subnet as disclosed above in Huat et al. (column 3 lines 45 - 53) can be a hybrid wireless IP phone for the purpose of transmitting and receiving Voice – over- Internet –Protocol (VoIP) over both a wireless personal area network and a wireless local area network ([0029] [0030]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the teachings of Huat et al., Poier et al., and Baeder so that the

local network which is one of the subnets disclosed above in Huat et al. is a wireless network which allows access to wireless IP phones for the purpose of transmitting and receiving VoIP .

Response to Arguments

6. Applicant's arguments with respect to claims 1- 14 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SONIA GAY whose telephone number is (571)270-1951. The examiner can normally be reached on Monday to Thursday from 7:30 AM to 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar can be reached on (571) 272-7488. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit: 2614

/Sonia Gay/

Examiner, Art Unit 2614

October 10, 2008

/Ahmad F. Matar/

Supervisory Patent Examiner, Art Unit 2614